

REMARKS:

By the foregoing amendment, Applicant responds fully to the Office Action dated July 6, 2005. Claims 1, 8 and 9 have been amended by the present amendment. Claims 28–29 have been newly added by the present amendment.

5 Three paragraphs of the specification have been amended by the present amendment in response to the Examiner’s objection to disclosure. Specifically, the paragraphs starting on Page 8, Line 20, on Page 10, Line 1 and on Page 11, Line 1, respectively, have been amended to correct typographical errors. No new matter has been added by the amendments to the respective paragraphs.

10 Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (US 5,405,347). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Carbide Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).” See MPEP §2131 8th Ed., Rev. 1, (February 2003). Claim 1
15 has been amended by the present amendment to more particularly point out and distinctly claim the present invention. Specifically, Claim 1 has been amended to further recite that the bar has a first end and a second end, that the bar first end is outside of the channel when the bar second end is between the channel first end and the channel second end when the first member is offset in the first direction from the second member, and that
20 the bar second end is outside of the channel when the bar first end is between the channel first end and the channel second end when the first member is offset in the second direction from the second member.

Lee discloses in Col. 5 starting at Line 3 that a screw 46 is rotated within a threaded bore 57 of a dovetail rail 56 to cause upper component 52 of the lateral adjustment mechanism 12 to travel within the dovetail slot 42. Screw 46 can only be used to position the rail to be offset from the slot in a single direction moving away from the end of the slot 42 adjacent slot 45. This is because the head of the screw appears incapable of being received within the bore, and that the dovetail rail is incapable of passing through collar 50. Lee therefore discloses a rail that is incapable of being offset from either end of the slot, as would be required by amended Claim 1 of the present invention. Since Lee fails to disclose each and every limitation of amended Claim 1, Claim 1 is not anticipated by Lee. It is therefore believed that amended Claim 1 is allowable over Lee.

Claim 1 also stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Schneebeli et al. (CH 638,095 A5) in view of Erickson (US 1,302,336). In order for a claim to be obvious under 35 U.S.C. 103, the references must teach or suggest all the claim limitations. See MPEP 8th Ed., Rev. 1, §706.02(j), (February 2003). Further, “[t]o establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP 8th Ed., Rev. 1 §2143.03, (February 2003). It should therefore follow by negative implication that where each claim limitation is not shown, the Examiner has failed to demonstrate *prima facie* obviousness.

Schneebeli teaches a locking screw 4 mounted in a rotary fashion. Screw 4 acts to shift the slider with respect to the intermediate body. However, the head of the screw allows for only one end of the slider to be offset from the intermediate body in a single

direction. Amended Claim 1 of the present invention requires that the bar be capable of being offset from the channel in two directions. Neither Shcneebeli nor Erickson show bidirectional offset capabilities. Since the cited references fail to show each and every limitation of Amended Claim 1, it is believed that amended Claim 1 is not obvious in view of these references.

Further, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, USPQ 1125 (Fed. Cir. 1984)." See MPEP 8th Ed., Rev. 1, (February 2003). Applicant respectfully asserts that removal of screw 46 in Lee or screw 4 in Schneebeli would render those inventions unsatisfactory for their intended purposes, respectively, since they would not be able to perform their offset or shifting functions as taught.

Applicant respectfully asserts that Claim 1, as amended, is now allowable.

Claims 2-7 stand rejected based on the reasons provided in the Office Action.

Claims 2-7 depend from Claim 1, which is now believed to be allowable. It is therefore believed that Claims 2-7 are now allowable as well.

Claim 8 stands rejected under 35 U.S.C. 102(b) as being anticipated by Lee.

Claim 8 has been amended by the present amendment to more particularly point out and distinctly claim the present invention. Specifically, Claim 8 has been amended to further recite that the bar has a first end and a second end, that the bar first end is outside of the channel when the bar second end is between the channel first end and the channel second end when the first member is offset in the first direction from the second member, and that the bar second end is outside of the channel when the bar first end is between the

channel first end and the channel second end when the first member is offset in the second direction from the second member.

As described above, Lee discloses in Col. 5 starting at Line 3 that a screw 46 is rotated within a threaded bore 57 of a dovetail rail 56 to cause upper component 52 of the lateral adjustment mechanism 12 to travel within the dovetail slot 42. Screw 46 can only be used to position the rail to be offset from the slot in a single direction moving away from the end of the slot 42 adjacent slot 45. This is because the head of the screw appears incapable of being received within the bore, and that the dovetail rail is incapable of passing through collar 50. Lee therefore discloses a rail that is incapable of being offset from either end of the slot, as would be required by amended Claim 8 of the present invention. Since Lee fails to disclose each and every limitation of amended Claim 8, Claim 8 is not anticipated by Lee. It is therefore believed that amended Claim 8 is allowable over Lee.

Claim 8 further stands rejected under 35 U.S.C. 102(b) as being anticipated by Schneebeli. Schneebeli teaches a locking screw 4 mounted in a rotary fashion. Screw 4 acts to shift the slider with respect to the intermediate body. However, the head of the screw allows for only one end of the slider to be offset from the intermediate body in a single direction. Amended Claim 8 of the present invention requires that the bar be capable of being offset from the channel in two directions. Schneebeli fails to teach or suggest bidirectional offset capabilities. Since Schneebeli fails to show each and every limitation of Amended Claim 8, it is believed that amended Claim 8 is not anticipated by Schneebeli.

Further, applicant respectfully asserts that amended Claim 8 is not obvious in view of either of these references. The removal of screw 46 in Lee or screw 4 in Schneebeli would render those inventions unsatisfactory for their intended purposes, respectively, since they would not be able to perform their offset or shifting functions as taught.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebeli in view of Erickson. Neither Schneebeli nor Erickson show bidirectional offset capabilities. Since the cited references fail to show each and every limitation of Amended Claim 8, and also since Schneebeli would be rendered unsatisfactory for its intended purposes for the reasons provided above, it is believed that amended Claim 8 is not obvious in view of these references.

Applicant respectfully asserts that Claim 8, as amended, is now allowable.

Claim 9 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 has been amended by the present invention to comply with 35 U.S.C. 112, second paragraph. Claim 9 further stands rejected for the other reasons provided in the Office Action. Claim 9 depends from Claim 8, which is now believed to be allowable. Claim 9 is now believed to be allowable as well.

Claim 10 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 has been amended by the present invention to comply with 35 U.S.C. 112, second paragraph. The amendment to Claim 9 is

believed to overcome the rejection of Claim 10. Claim 10 further stands rejected for the other reasons provided in the Office Action. Claim 10 depends from a base claim that is now believed to be allowable. Claim 10 is now believed to be allowable as well.

Claim 11 further stands rejected for the other reasons provided in the Office
5 Action. Claim 11 depends from a base claim that is now believed to be allowable. Claim 11 is therefore believed to be allowable as well.

Claim 28 has been newly added by the present amendment. Claim 28 depends from Claim 1, and further recites that the bar ends are solid bar ends that are incapable of receiving a screw to hold the second member in position relative to the first member. Lee
10 shows a screw for being received within the end of a rail to position the rail within a slot, and Schneebeli shows a screw for being received within the end of a slider for shifting the slider within a body. Claim 28 recites a limitation in direct contradiction to these references. These references therefore teach away from the requirements of Claim 28. Claim 28 is believed to be allowable for these reasons and also because it depends from a
15 base claim that is believed to be allowable.

Claim 29 has been newly added by the present amendment. Claim 29 depends from Claim 8, and further recites that the bar ends are solid bar ends that are incapable of receiving a screw to hold the second member in position relative to the first member. Lee shows a screw for being received within the end of a rail to position the rail within a slot,
20 and Schneebeli shows a screw for being received within the end of a slider for shifting the slider within a body. Claim 29 recites a limitation in direct contradiction to these references. These references therefore teach away from the requirements of Claim 29.

Claim 29 is believed to be allowable for these reasons and also because it depends from a base claim that is believed to be allowable.

In summary, it is believed that Claims 1-11 and 28-29 are now in condition for allowance. Favorably action to that end is respectfully requested.

5 Signed at Fond du Lac, Wisconsin, this 05 day of October, 2005.

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Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'N. Brannen', with a long horizontal line extending to the right.

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